

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AMIR HERZBERG, YEHIEL YOCHAI, ELDAD SHAI
and BOAZ BINNUM

Appeal No. 2005-1501
Application 09/625,006

ON BRIEF



Before GROSS, SAADAT, and MACDONALD, **Administrative Patent Judges.**

MACDONALD, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-6, 9, 11-20, and 23-35. Claims 7-8, 10, and 21-22 have been canceled.

Invention

Appellants' invention relates to a method, apparatus, and computer software product for a merchant offering content for sale, preferably in the form of "click and pay" Web pages, each with a designated price to the buyer and commission rate to the advertiser. The merchant publishes the price of the content, as well as the commission rates and any other conditions relevant to the advertiser, so that the advertiser may decide whether and how to publish an advertisement for the item. For each page, the merchant defines an alias, identifying the page in such a manner that only the merchant can determine, upon receiving a request for the alias, the real page that is requested. The alias is preferably specific to the advertiser, so that the merchant and/or the billing server, can determine the identity of the advertiser from the alias used. The merchant provides the advertiser with the alias upon request. The advertiser includes the alias in code, preferably in a mark-up language such as HTML, XML or WML, that is used in an advertisement offering the merchant's content on a Web site belonging to the advertiser. The advertiser also receives a password from the merchant, which is then used by the merchant to authenticate content requests made by the advertiser. Appellants' specification at page 5, line 13, through page 6, line 5.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A method for electronic advertising, comprising:

providing a plurality of different aliases to represent a network address of an item offered by a merchant for sale on a page per fee basis at a predetermined price, all of the plurality of aliases representing the same network address;

assigning respective aliases from among the plurality of different aliases to a plurality of advertisers for use by the advertisers in advertising the item and in receiving payment for the sale of the item, such that each respective alias from among the plurality of aliases is assigned by the merchant to specifically identify a respective one of the plurality of advertisers;

posting an advertisement offering the item to a buyer for purchase via a network link represented in the advertisement by the respective alias, which conceals the network address from the buyer;

receiving an invocation of the link from the buyer;

responsive to the invocation, transmitting an order to the merchant for supply of the item to the buyer in exchange for payment of the price by the buyer, the order comprising a message including the respective alias;

conveying the item, responsive to the order, from the merchant to the buyer; and

receiving, responsively to the respective alias, a predefined portion of the price paid by the buyer in consideration for posting the advertisement.

References

The references relied on by the Examiner are as follows:

Messer	5,991,740	November 23, 1999
Barber	6,157,917	December 5, 2000

Appeal No. 2005-1501
Application 09/625,006

Rejections At Issue

Claims 1-6, 9, 11-20, and 23-35 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Messer and Barber.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 1-6, 9, 11-20, and 23-35 under 35 U.S.C. § 103.

Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellants

¹ Appellants filed an appeal brief on January 14, 2004. Appellants filed a reply brief on June 4, 2004. The Examiner mailed an Examiner's Answer on April 6, 2004.

Appeal No. 2005-1501
Application 09/625,006

[see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004
replacing 37 CFR § 1.192(a)].

**Whether the Rejection of Claims 1-6, 9, 11-20, and 23-35 Under
35 U.S.C. § 103 is proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 1-6, 9, 11-20, and 23-35. Accordingly, we reverse. We will treat claim 1 as exemplary of claims 1-6, 9, 11-20, and 23-35.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants.

Appeal No. 2005-1501
Application 09/625,006

Oetiker, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1, Appellants argue at page 7 of the brief, "*Barber neither teaches nor suggests the use of a plurality of different aliases to represent the same network address, as required by claim 1.*" The Examiner's rejection takes the position that multiple aliases would be inherent (answer at page 4).

We find no basis for the Examiner's statement of inherency. We readily see alternatives to "multiple aliases" for implementing the method of the references. Therefore, the use of

Appeal No. 2005-1501
Application 09/625,006

multiple aliases cannot be said to be inherent. To be inherent, evidence must make clear that the missing descriptive matter is **necessarily** present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.

Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

The Examiner modifies the inherency position later in the answer by also contending that Barber teaches such a feature by including a payee identifier in the alias link (col. 8, line 21) thus making the alias unique from different advertiser sites. Appellants rebut this contention at page 3 of the reply brief by pointing out that the Examiner is correct as to the teaching of Barber. However, Appellants further point out that this teaching in fact supports Appellants' argument rather than the Examiner's contention. We agree with Appellants position on this point.

Therefore, the Examiner has not met the initial burden of establishing a **prima facie** case of obviousness, and we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

Appeal No. 2005-1501
Application 09/625,006

Conclusion

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 103 of claims 1-6, 9, 11-20, and 23-35.

REVERSED

Anita Peltman Gross

ANITA PELLMAN GROSS
Administrative Patent Judge

Mahshid D. Saadat

MAHSHID D. SAADAT
Administrative Patent Judge

Allen R. MacDonald

ALLEN R. MACDONALD
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Appeal No. 2005-1501
Application 09/625,006

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